Remarks

Reconsideration of the above-captioned application is respectfully requested. Claims 1, 7, and 14 have been rejected under 35 U.S.C. §102 as being anticipated by Hoyle (USPN 6,141,010), and all pending claims (1-4, 6-11, and 13-19) have been rejected as being unpatentable over Barnett et al. (USPN 6,336,099) in view of Landsman et al. (USPN 6,317,761).

To overcome the present rejections, all independent claims now recite that

(1) in contrast to Hoyle, which automatically determines which saved banner to display to the user, in the present invention the user may select a saved advertisement for display;

(2) unlike Hoyle, which displays only a single banner in the relied-upon Figure 5, the present advertisement history window presents plural advertisements;

(3) unlike Barnett et al., which downloads coupons (relied on as the claimed "advertisements") only upon user request, the present advertisements are downloaded automatically without the user requesting them (Claim 1, as supported on page 4 and page 7, last paragraph), or while the user is engaged in activity other than requesting the advertisements (Claim 7, as supported on pages 4 and 7), or automatically in response to a user request for information other than the advertisements (Claim 14, as supported on page 4, second paragraph of the description); and

(4) unlike Barnett et al., which as readily admitted in the Office Action fails to teach allowing a user to access a web site by clicking on the coupons, a user of the present invention may access a web site from the saved advertisement when the advertisement is toggled.

Rejections Under 35 U.S.C. §102

Claims 1, 7, and 14 have been rejected under 35 U.S.C. §102 as being anticipated by Hoyle, which is directed to delivering targeted advertisements by monitoring the actions of the user to determine what the user may be interested in at the moment. If the user accesses a financial website, or executes an accounting application, then the user may see a banner advertisement for Bank of America etc. Hoyle in essence teaches away from the present invention in that Hoyle presents only targeted advertisements as determined by the system, not the user, whereas in the present claims the user selects an advertisement for display so that the user need not deviate from the task at hand, but later cares to further explore a recently displayed advertisement that looked interesting.

Thus, while Hoyle seeks to automatically download advertisements in a targeted manner, the present invention seeks to allow a user to later display an advertisement regardless of whether the advertisement was downloaded intelligently. There simply is no teaching or suggestion in Hoyle to enable a user to recall a recently displayed advertisement that may have interested a user - a user momentarily busy with another task but interested in further exploring the advertisement at a later time.

Furthermore, the examiner's attempt to equate the single banner in Figure 5 of Hoyle with the claimed advertisement history window is too much of a stretch even under the guise of broad claim interpretation during prosecution, because Figure 5 of Hoyle shows only a single banner, whereas the claimed history window shows plural advertisements. Since Hoyle does not seek to enable a user to select an advertisement for display, there is no suggestion in Hoyle of the claimed history window. The claims are patentable over Hoyle.

Rejections Under 35 U.S.C. §103

Claims 1-4, 6-11, and 13-19 have been rejected under 35 U.S.C. §103 as being unpatentable over Barnett et al., which downloads coupons to a user upon request so that the user can print out the coupons and take them to a store, col. 7, lines 12-15, in view of Landsman et al. Modifying Barnett et al. to download the coupons automatically as now recited in the case of the present advertisements would defeat a purpose of Barnett et al. (to allow a user to decide what coupons to download) and thus would be improper under MPEP §2143.01 (citing In re Gordon), rendering the present claims patentable.

In addition, the allegation that it would have been obvious to modify Barnett et al. to access a Web site by clicking on one of its coupons because Landsman et al. teaches accessing Web sites when advertisements are clicked continues to lack support in the prior art. Regardless of whether advertising information can be contained in the coupons of Barnett et al., they remain coupons intended to be printed out and redeemed. That is why, as the examiner has been forced to confess, Barnett et al. nowhere teaches accessing web sites by clicking its coupons. Landsman et al. is not directed to coupons or for that matter to advertising contained in coupons.

So where is the ***prior art*** motivation to combine? "To provide the users of Barnett with a familiar interface and an ability to access further advertisement information", according to the rejection. But the users of Barnett et al. already have a "familiar interface" (a browser), and nowhere does Barnett et al. motivate accessing further information, because it is directed to increasing sales through coupons, not to marketing through advertising. Indeed, Barnett et al.'s casual comment that its coupon file might include advertising (the fact that the advertising consists of "graphics, text, etc." is irrelevant because regardless of its format it is all contained in the coupon file) is simply inadequate to motivate the skilled artisan to toss in the ability

to access a web site by clicking on the coupon, ***because the user already is at the intended web site of Barnett et al. by virtue of affirmatively downloading the coupons***. Applicant has quite accurately characterized Barnett et al. and has correctly noted for the above reasons that Barnett et al. and Landsman et al. are apples and oranges, a point that the Board most assuredly will not brush off so lightly.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,

John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

JLR:jg

1176-3.AM3